UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,522	09/29/2003	Mark Bernard Hettish	2003P08061US	1651

7590	05/14/2007

Siemens Corporation
Attn: Elsa Keller, Legal Administrator
Intellectual Property Department
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EXAMINER
PADMANABHAN, KAVITA

ART UNIT	PAPER NUMBER
2161	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/673,522	HETTISH, MARK BERNARD
	Examiner	Art Unit	
	Kavita Padmanabhan	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 February 2007</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-7 and 9-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-7 and 9-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 September 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ :

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   Claims 1 and 18-20 have been amended.

2.   Claims 1-7 and 9-20 are pending.

3.   Claims 1-7 and 9-20 are rejected.

Continued Examination Under 37 CFR 1.114

4.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 2/26/07 has been entered.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

7.   **Claims 1-7 and 9-20** are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claims 1 and 18-20 recite the limitation "said device context" in lines 3, 3, 5, and 8,

respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9.   **Claims 1-7 and 9-20** are rejected under 35 U.S.C. 102(b) as being anticipated by

Diacakis et al. (US 2002/0116336, hereinafter "Diacakis").

In regards to **claim 1, Diacakis** teaches a method, comprising:

–   detecting a new device context for a specific device associated with an identity

      (Diacakis; par [0034], lines 14-18; par [0035], par [0038]; par [0043]-par

      [0044]),wherein said device context provides an availability status of the specific device

      (Diacakis; par [0026]; par [0045]; par [0053]); and

–   mapping said new device context to an identity context for said identity by associating

      the new device context with said identity context for said identity, wherein said identity

      context provides an availability status of said identity **(Diacakis; par [0056]; [0059];**

      Fig. 8); and

–   providing data indicative of said mapped identity context **(Diacakis; par [0056]; par**

      [0059]; Fig. 8).

In regards to **claim 2, Diacakis** teaches the method of claim 1, wherein said detecting said new device context for said device includes detecting said new device context in a presence and availability service **(Diacakis; Fig. 1)**.

In regards to **claim 3, Diacakis** teaches the method of claim 1, wherein said detecting said new device context for said device includes receiving a request to change said device's device context **(Diacakis; par [0034], lines 14-18)**.

In regards to **claim 4, Diacakis** teaches the method of claim 1, wherein said mapping said new device context to said identity context for said identity includes determining said identity **(Diacakis; par [0056]; Fig. 8)**.

In regards to **claim 5, Diacakis** teaches the method of claim 1, wherein said mapping said new device context to said identity context for said identity includes determining said identity context **(Diacakis; par [0056]; par [0059]; Fig. 8)**.

In regards to **claim 6, Diacakis** teaches the method of claim 1, further comprising:

– determining said identity **(Diacakis; par [0056]; Fig. 8)**.

In regards to **claim 7, Diacakis** teaches the method of claim 1, further comprising:

– determining said identity context **(Diacakis; par [0056]; par [0059]; Fig. 8)**.

In regards to **claim 9**, **Diacakis** teaches the method of claim 1, wherein said providing data indicative of said identity context includes providing said data indicative of said identity context to an identity context oriented application **(Diacakis; par [0030]; par [0056]; par [0059]; Fig. 8)**.

In regards to **claim 10**, **Diacakis** teaches the method of claim 1, further comprising:

— receiving a request to make a change to a new identity context for an identity **(Diacakis; par [0034], lines 14-18; par [0056]; par [0059]; Fig. 8)**; and

— mapping said new identity context to a device context for a device associated with said identity **(Diacakis; par [0056]; par [0059]; Fig. 8)**.

In regards to **claim 11**, **Diacakis** teaches the method of claim 1, further comprising:

— receiving a request to make a change to a new identity context for a second identity **(Diacakis; par [0034], lines 14-18; par [0056]; par [0059]; Fig. 8)**; and

— mapping said new identity context to a device context for a device associated with said second identity **(Diacakis; par [0056]; par [0059]; Fig. 8)**.

In regards to **claim 12**, **Diacakis** teaches the method of claim 11, wherein said receiving said request to make said change to a new identity context for said second identity includes receiving said request from an identity context oriented application **(Diacakis; par [0034], lines 14-18; par [0036])**.

In regards to **claim 13**, **Diacakis** teaches the method of claim 11, wherein said mapping said

new identity context to said device context for said device associated with said second identity

includes determining said device associated with said second identity **(Diacakis; par [0056];**

par [0059]; Fig. 8).

In regards to **claim 14**, **Diacakis** teaches the method of claim 13, wherein said mapping said

new identity context to said device context for said device associated with said second identity

includes determining said device context associated with said device associated with said second

identity **(Diacakis; par [0056]; par [0059]; Fig. 8)**.

In regards to **claim 15**, **Diacakis** teaches the method of claim 11, wherein said mapping said

new identity context to said device context for said device associated with said second identity

includes accessing a mapping table **(Diacakis; Fig. 2; Fig. 5; Fig. 8)**.

In regards to **claim 16**, **Diacakis** teaches the method of claim 1, further comprising:

– providing data indicative of said device context to a presence and availability service

   (Diacakis; Fig. 1; par [0034], lines 14-18; par [0035], par [0038]; par [0043]-par

   [0044]; Fig. 8).

In regards to **claim 17**, **Diacakis** teaches the method of claim 11, further comprising:

  − changing an identity context for said second identity from a first identity context to a said

  new identity context in response to said request **(Diacakis; par [0034], lines 14-18; par

  [0056]; par [0059]; Fig. 8).**

Claim 18 is rejected with the same rationale given for claim 9.

Claims 19 and 20 are each rejected with the same rationale given for claim 1.

Response to Arguments

10.   Applicant's arguments filed 2/26/07 with respect to the prior art rejections of the claims

have been fully considered but they are not persuasive.

Applicant argues that Diacakis does not teach the claimed detecting a new device context for

a specific device associated with an identity, wherein the device context provides an availability

status of the specific device, mapping the new device context to an identity context for the

identity, and providing data indicative of the mapped identity context. Specifically, applicant

argues that the claimed new device context relates to a specific device and provides an indication

of an availability status of the specific device.

The examiner respectfully disagrees. The examiner asserts that Diacakis does indeed teach

the claimed limitations. Par [0043] of Diacakis states, in part, "to determine if the individual is

present on a landline telephone, for example, the landline desk phone 44 in his office," and "to

determine if the individual is present on his mobile phone 46." Par [0044] states, in part, "to

determine whether an individual is present on other devices such as, for example, a personal

digital assistant (PDA) 50 or a pager 52." A landline telephone is clearly a specific device for

which an availability status is determined, as is a PDA. Furthermore, Figure 8 of Diacakis

clearly shows a mapping of a device context for a specific device associated with the identity,

e.g. work telephone is available, to an identity context, e.g. Jonathan is available.

Applicant argues that, in contrast to the claims, Diacakis teaches determining an availability

of an individual and an availability of a communication network, but does not teach the

availability of a specific device.

The examiner respectfully disagrees. The examiner asserts that Diacakis does indeed teach

determining the availability of specific devices. The examiner asserts that Figure 8 of Diacakis

goes beyond what is argued by the applicant and shows not only that Jonathan is available via

telephone, but also the specific telephone devices and their corresponding availabilities, i.e.

device contexts. For example, his work phone is available.

Applicant argues Diacakis fails to overcome the problems addressed by applicant's

invention. Applicant cites pars [0028] – [0031] of applicant's specification for explanation. In

response, the examiner asserts that Diacakis meets the language of the claims, as written. The

examiner further asserts that although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

11.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to **Kavita Padmanabhan** whose telephone number is **571-272-**

8352. The examiner can normally be reached on Monday-Friday, 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SUPERVISORY PATENT EXAMINER